

SM



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/607,142	06/29/2000	Joel Cherry	5443.424-US	7060

25908 7590 03/05/2004

NOVOZYMES NORTH AMERICA, INC.  
500 FIFTH AVENUE  
SUITE 1600  
NEW YORK, NY 10110

EXAMINER

MAHATAN, CHANNING

ART UNIT	PAPER NUMBER
----------	--------------

1631

DATE MAILED: 03/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

S.M.

<b>Advisory Action</b>	<b>Application No.</b> 09/607,142	<b>Applicant(s)</b> CHERRY ET AL.	
	<b>Examiner</b> Channing S Mahatan	<b>Art Unit</b> 1631	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 02 February 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☒ they raise the issue of new matter (see Note below);
  - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 41-57.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☒ The drawing correction filed on 18 July 2002 is a) ☒ approved or b) ☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.

10. ☐ Other: \_\_\_\_\_

*Marianne P. Allen*  
**MARIANNE P. ALLEN**  
**PRIMARY EXAMINER**

*March 4, 2004* *A41631*

*CSM*

Continuation of 2. NOTE: Applicants arguments and amendments to claims 41 and 54-57 do not overcome the rejections of record and may result in new rejections. For instance, Applicants' submit the term "repeating" (claims 54-57; 35 U.S.C. 112 2nd Paragraph Rejection) is well understood by a skilled artisan, wherein the number of times in which the steps will be repeated is at the discretion of the artisan. This is unpersuasive because a skilled artisan would be unable to understand at what point one would stop the repeating process (i.e. the steps of modeling and identifying in claim 41 may be repeated unlimitedly in the absence of criterias establishing when to stop). Additionally, Applicants have amended claims 55-57 by adding the language "maltogenic alpha-amylase activity"; it is noted Applicants did not point to particular support for said amendment. It appears support for "maltogenic alpha-amylase activity" is found on page 3, lines 32-37 which states: "The maltogenic alpha-amylase is an enzyme classified in EC3.2.1.133. The enzymatic activity does not require a non-reducing end on the substrate and the primary enzymatic activity results in the degradation of amylopectin an amylose to maltose and longer maltodextrins. It is able to hydrolyze amylose and amylopectin to maltose in the alpha-configuration, and is able to hydrolyze maltotriose as well as cyclodextrin". However, the language "primary enzymatic activity" infers the presence of additional activities for maltogenic alpha-amylase (i.e. secondary), which can not be found nor is identified in the original disclosure and may result in new rejections under 35 U.S.C. 112 1<sup>st</sup> Paragraph (New Matter) and 35 U.S.C. 112 2<sup>nd</sup> Paragraph (Vague and Indefinite). Therefore, the proposed amendments will not be entered and the rejections in the previous office action, mailed 04 November 2003, are maintained for reasons of record. Further, the proposed claim limitations require further consideration and search.